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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,914	06/01/2001	Ferdinand Schermel		4663

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EXAMINER

CASTELLANO, STEPHEN J

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 01/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

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Commissioner of Patents and Trademarks

see attached


Stephen J. Castellano
Primary Examiner
Art Unit: 3727

Applicant has responded in three separate correspondences, a first submission, paper No. 19 filed November 23, 2002, a second submission, paper No. 20 filed December 5, 2002, and a third submission, paper No. 21 filed December 12, 2002. All three correspondences are responded to in this letter.

For clarity, the examiner invokes 37 CFR 1.126.

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 4.5 and 5.5 have been renumbered as claims 22 and 23.

Regarding the new matter, applicant submits evidence of a claim for priority found on the transmittal sheet wherein priority is claimed for provisional application serial No. 60/209,964, a copy of page 6 of this provisional application is also submitted. Applicant's present application 09/872,914 must be complete as originally filed and must contain support for all claimed subject matter within itself. The present application can not rely on the provisional applications for additional support of the claimed subject matter. This issue of new matter is not the major issue. Consideration of new matter is a serious matter when applicant is considering whether to file a continuation-in-part (CIP), containing new matter, or a continuation or divisional which would not contain new matter.

Regarding the issue of the non-elected subject matter, applicant submits that claims 1 and 2 are not mutually exclusive. This is not the question which the examiner is concerned. The

question which the examiner is concerned is whether the claims now presented, claims 1, 3-7 and 9-23 are the elected invention. Claims 11-21 do not pertain to the elected invention since they pertain to a method of use of increasing the effective volume of a wheeled container and the claims to the modular wheeled container system have a constant volume rather than an increase in effective volume.

The issue in dispute and the most important issue now present is whether claims 1, 3-7, 9, 10, 22 and 23 are the elected invention by original presentation. All the claims originally filed and as amended by amendment A filed April 24, 2002, paper No. 6 are compared with the claims now of record, the claims as amended by amendment C filed October 9, 2002 as paper No. 16. Claim 1 as originally filed includes a wheeled container, at least one attachable container and a means for securing the wheeled container and the attachable container, this configuration was shown by Fig. 1 and 9-11. Claim 2 as originally filed further includes a plurality of attachable containers stacked and secured on to the attachable container, a configuration where at least three containers are stacked and a fourth container is wheeled, not shown in Fig. 1-11. The amendment of paper No. 6 doesn't change either claim 1 or claim 2. Now, claim 1 states a wheeled container, a first attachable container which rests on top of the wheeled container, a second attachable container which rests on top of the first attachable container, a means for securing wherein the top supporting edge of the wheeled container is secured to the bottom supported edge or face of the first attachable container, not shown in Fig. 1-11. Claim 1 now requires a stack of three containers wherein the bottom container is a wheeled container, this was never claimed. Since claim 1 now claims something different than the original claims and not

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covered by any of the original drawings and seems properly restrictable by original presentation as being directed to another specie, then claim 1 should not be examined in this RCE.

The replies filed on November 23, 2002, December 5, 2002 and December 12, 2002 are not fully responsive to the prior Office Action because of the following omission(s) or matter(s): Applicant has not properly filed an RCE. An RCE can not include divisional subject matter. The filing of the RCE can not be considered as a CPA because the original application was filed on June 1, 2001 after May 29, 2000. Therefore, applicant's options include the filing of a continuation under 37 CFR 1.53(b) if he wants to have the newly presented amended claims examined. Since these amendments include new matter, applicant should file a Continuation-in-part (CIP) under 37 CFR 1.53(b). See 37 CFR 1.111. Since the period for reply set forth in the prior Office action has expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a).


The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply outside the SIX (6) MONTH statutory period or obtain an extension for more than FIVE (5) MONTHS beyond the date for reply set forth in an Office action. A fully responsive reply must be timely filed to avoid abandonment of this application.

All further communication should be in writing as stated in the interview summary filed September 26, 2002 as paper No. 14.

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The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Stephen J. Castellano
Primary Examiner
Art Unit 3727

sjc
December 19, 2002